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09/308,114

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AKEMI SAWADA

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21706 7590 11/18/2003

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EXAMINER

MEHRA, INDER P

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 11/18/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/308,114

Applicant(s)

SAWADA, AKEMI

Examiner

Inder P Mehra

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

1. This is in response to an amendment B dated 9/8/03 which has been fully considered and made of record. Based on this amendment, claims 12 and 22 have been amended. Claims 1-11 were cancelled in Amendment A dated 1.6.03. Claims 12-22 are now pending.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate "communication terminals", refer to specification page 4 lines 5-6 and "subscriber device", refer to claim 12 and line 17. Applicant argued that "common terminal" is "common terminal point", and argued that specification at page 9 describe the subscriber device sufficiently to one of even ordinary skill in the field. This argument is persuasive. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "11" has been used to designate both communication device, specification page 4 lines 5-6 and subscriber device, refer to claim 12 and line 17. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claim 13 recites the limitation "the switching system" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "switching system " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the switching system" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation, "the service identification number" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "internet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 is objected to because of the following informalities: Refer to the limitation, "a line" in line 8, and "the line" in line 17, This limitation is not supported by specification. In the specification, "the subscriber line" is disclosed, refer to page 4 line 9.

Appropriate correction is required.

### *Specification*

4. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood:

a. Refer to specification page 9 line 18. The access server makes it possible for a subscriber device, which is connected with the subscriber switching system 14 not through the switch 15 but directly, to make an access to the LAN 16. In fig. 1, access is through the switch 15 and not directly. Appropriate correction/clarification is required is required

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

b. Refer to specification page 4 line 14. Specification disclose, "Accommodated subscriber lines 11 at each switching station may be divided into two or more classes---". It is not clear as to what classes are being referred to?

Appropriate correction/clarification is required is required. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al** (U.S. 6,157,648 A), hereinafter **Volt** in view of **Tonnby et al** (US Patent No. 6,515,996), hereinafter **Tonnby**.

Regarding claims 12 and 13, **Voit et al.**, in fig. 3, disclose a communications system comprising:

- **branching means (312) connected with a subscriber line (344); switching system (310) connected with one terminal 340 of the branching means**

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**(common terminal); and information provider server (314), as recited in claims 12 and 13, LAN 330 provided as associated with the switching system, and connected with another terminal of the branching means, for providing a subscriber device (340) with information through the subscriber line.**

Moreover, one or more **information providing servers** (316 and 324) are placed together with the switching system means (310) in a corresponding switching station.

Voit does not disclose **expressly LAN and “branching means with two terminals”;**

Tonnby discloses IP gateway 8, fig. 1, **(branching means)** and LAN which supports communication using IP protocol **(second terminal)**, from an IP based network and is, further, associated with PSTN/ISDN network 3 **(switching system) (second terminal)**, fig. 3, and col. 2 line 65.

A person of ordinary skill in the art would have been motivated to employ Tonnby's modem with IP support into Voit's session management system in order to achieve LAN associated with switching system. The suggestion/motivation to do so would have been to have digital simultaneous transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to packetize speech and data in order to use single line and transmit simultaneously to PSTN/ISDN (switching system) and Internet over the LAN.

Regarding claim 14, Voit discloses “information providing server” comprising a **document browsing server**, refer to col. 22 lines 24-39.

Regarding claim 15, Voit discloses ISP email address, refer to col. 16 lines 49-50,  
**(information providing server comprising mail server).**

7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al** (U.S. 6,157,648 A), hereinafter Volt in view of **Tonnby et al** (US Patent No. 6,515,996), hereinafter Tonnby and further in view of **Lieu et al** (US Patent No. 6,349,096), hereinafter Lieu.

Regarding claims 16 and 17, Voit does not disclose expressly the following limitations:

- **the call-out information --- generated in response to a call-out signal ---on the subscriber line, as recited by claim 16;**
- **branching means connects the subscriber line with the switching system - ---subscriber line, as recited by claim 17;**

Liu , in fig. 3, discloses a communications system comprising: **branching means** (241), **switching system means** (242), **information provider server** (243) with structure and functions as claimed. Besides, the branching means (241) separates signals based on **frequency bands**, and it is inherent that, for 2way communication, the branching means (241) connects the **subscriber line (225) with the switching system means (242) in response to a call-out signal sent from the switching system means to the subscriber line**, refer to col. 7 lines 17-22.

A person of ordinary skill in the art would have been motivated to employ Lieu's system into Voit's session management system in order to achieve switching system. The suggestion/motivation to do so would have been to have digital simultaneous transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to transmit simultaneously to PSTN/ISDN (switching system) and Internet over the LAN.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al.** (U.S. 6,157,648 A), hereinafter **Voit**, in view of **Tonnby et al.** (US Patent No. 6,515,996), hereinafter **Tonnby** and further in view of **MacNaughton et al.** (US Patent No. 5,796,393 A), hereinafter **MacNaughton**.

Regarding claims 18 and 19, **Voit** and **Tonnby** discloses a communications system as discussed in claim 12 above.

**Voit**, however, fails to clearly teach that the subscriber line is connected with the information providing **server based on a service identification number**, and an information providing server provided for **each community is accessed by inputting the service identification number followed by a corresponding community identification code**.

**MacNaughton**, in col. 9, lines 2-18, teaches that in a communications system having a plurality of **information servers** (local and foreign servers), when the user requests access to a community server, information such as **service ID number (community identification number)** and **community identification code (community text name)** need to be supplied to **establish a connection from the user to the community server**.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to apply **MacNaughton's** teaching in **Voit's** system to reduce burden for routers in **Voit** and provide quick connections to the users. Web users need the ability form on-line relationships with others and communicate with others of similar interests or background.



9. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al** (U.S. 6,157,648 A), hereinafter **Volt** in view of **Tonnby et al** (US Patent No. 6,515,996), hereinafter **Tonnby** and **Melen et al** (US Patent No. 5,956,391), hereinafter **Melen**.

Regarding claim 20, Voit does not disclose expressly the following limitation:

- **“access point to the internet is connected with the LAN”;**

Melen discloses **information provider servers (7, 8, 13) connected with an access point (10) to the Internet (11)**, and one of the servers is a **mail server (7), LAN network connecting router 6 with internet via router 10**, refer to fig. 2 and col. 7 lines 17-20;

A person of ordinary skill in the art would have been motivated to employ Melen's system into Voit's session management system in order to achieve connection between subscriber and internet. The suggestion /motivation to do so would have been to have transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to transmit simultaneously to PSTN/ISDN (switching system) and to Internet over the LAN.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al** (U.S. 6,157,648 A), hereinafter **Volt** in view of **Tonnby et al** (US Patent No. 6,515,996), hereinafter **Tonnby** and **Beyda et al** (US Patent No. 6,021,120), hereinafter **Beyda**.

Regarding claim 21, Voit does not disclose expressly, **“ the branching means separates signals based on frequency bands”;**

Beyda discloses **separation of signals based on frequency bands**, refer to col. 3 lines 13-16;

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A person of ordinary skill in the art would have been motivated to employ Beyda's system into Voit's session management system in order to achieve switching system. The suggestion /motivation to do so would have been to have transmission of voice and data on a single line. It would have been obvious to a person of ordinary skill in the art to split and route PSTN/ISDN (switching system) on one frequency and to Internet over the LAN on different (higher) frequency.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Voit et al** (U.S. 6,157,648 A), hereinafter Volt in view of **Tonnby et al** (US Patent No. 6,515,996), hereinafter Tonnby and further in view of **Hirono** (US Patent No. 6,424,818).

Regarding claim 22, Voit et al., in fig. 3, disclose a communications system comprising:

- **branching means (312) connected with a subscriber line (344); switching system (310) connected with one terminal 340 of the branching means (common terminal); and information provider server (314), as recited in claims 12 and 13, LAN 330 provided as associated with the switching system, and connected with another terminal of the branching means, for providing a subscriber device (340) with information through the subscriber line.**

Moreover, one or **more information providing servers (316 and 324)** are placed together with the switching system means (310) in a corresponding switching station.

Voit does not disclose **expressly** the limitations,

- **“ LAN and branching means with two terminals”, as recited by claim 22;**

- **communication system used together with a mobile switching system in a mobile switching station, as recited in claim 22;**

Tonnby discloses IP gateway 8, fig. 1, (**branching means**) and LAN which supports communication using IP protocol (second terminal), from an IP based network and is, further, associated with PSTN/ISDN network 3 (switching system) (second terminal), fig. 3, and col. 2 line 65;

Hiron discloses, in fig. 1, **communication system used together with a mobile switching system in a mobile switching station;**

A person of ordinary skill in the art would have been motivated to employ Hiron's mobile system and Tonnby's modem with IP support into Voit's session management system in order to achieve LAN associated with switching system. The suggestion/motivation to do so would have been to have digital simultaneous transmission of voice and data on a single line in wireless environments. It would have been obvious to a person of ordinary skill in the art to packetize speech and data in order to use single line and transmit simultaneously to PSTN/ISDN (switching system) and Internet over the LAN in mobile environment.

### ***Response to Arguments***

12. Applicant's arguments regarding claims 12-22 filed 9/8/03 have been fully considered but they are not persuasive.

Applicant argues that components recited by claims 12 and 22 are not taught or suggested by the prior art cited, taken alone or in the several combinations.

In response, it is stated that Voit '648 , in reference to fig. 3, discloses all the components: subscriber's device (PC 340); subscriber line (dial line 344), LAN (LAN 328),

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information providing server associated with the LAN (Information Providers 316, 318 and 324);.

Further, Applicant argues that Voit '648 does not disclose, "switching system".

In response, it is stated that Voit '648 discloses switching system ISDN, as part of Internet network, refer to col. 1 lines 45-90. Also, Tonnby discloses IP gateway 8, fig. 1, **(branching means)** and LAN which supports communication using IP protocol **(second terminal)**, from an IP based network and is, further, associated with PSTN/ISDN network 3 **(switching system) (second terminal)**, fig. 3, and col. 2 line 65.

Applicant argues that Voit '648 fails to teach or suggest the point of the invention that a LAN is associated with a switching system of a subscriber or mobile switching station and having at least one information providing server connected with the LAN.

In response. It is stated that Voit '648 discloses, " LAN 328 associated with switching system 332 (PSTN, refer to col. 2 lines 25-26) of a subscriber 340", refer to fig. 3; further, discloses information provider server (information providers 324) connected to the subscriber via the subscriber line 326, which is exemplary subscriber line.(dial link).

Applicant argues, "Tonnby '996 (second reference) discloses LAN 61, in reference to fig. 5, at the end of user's location , not at a switching station".

In response, it is stated that claim 1 recites, "a LAN associated with the subscriber switching system" and is therefore not necessary located at switching system. Location is not claimed. However, LAN, in fig. 3 of Voit '648 is located at the switching system 332.

Applicant argues that Tonnby '996 discloses, "PSTN as toll switching system and not subscriber switching system".

In response, it is stated that PSTN switching system is for illustrative purposes. Tonnby also discloses private automatic branch telephone exchange, refer to Tonnby's col. 10 lines 52-55.

*In the light of above explanation, arguments by applicant are not persuasive.*

**13. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### ***Conclusion***

15. Any enquiry concerning this communication should be directed to Inder Mehra whose telephone number is (703) 305-1985. The examiner can be normally reached on Monday through Friday from 8:30AM to 5:00 PM.

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If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Seema Rao , can be reached on (703) 308-5463. Any enquiry of a general nature of relating to the status of this application or processing should be directed to the group receptionist whose telephone number is (703) 305-4700.

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, DC. 20231

Or faxed to (703) 872-9314.

Hand -delivered responses should be brought to Crystal Park II, 2121 Crystal drive,  
Arlington, VA, sixth floor (Receptionist).

  
Inder Mehra

November 4, 2003

  
RAYMOND J. MILLER  
RECEIVED